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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,454	01/14/2002	Victor B. Kley	020921-001110US	3079
20350	7590	07/19/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			LUU, THANH X	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2878	

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

(A)

Office Action Summary**Application No.**

10/047,454

Applicant(s)

KLEY, VICTOR B.

Examiner

Thanh X Luu

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-42 and 55-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 10-19, 21-28, 31, 32, 40-42 and 55-57 is/are allowed.
- 6) ☒ Claim(s) 20, 29, 30 and 33-35 is/are rejected.
- 7) ☒ Claim(s) 36-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 4, 2004 has been entered.

Claims 1-8, 10-42 and 55-57 are currently pending.

Examiner also notes, at least to the amendment to claim 20, it does not show all the changes made to the claim. For instance, in claim 20, the removal of the language of "said non-optical interaction being other than a tunneling current..." was not struck-through as customarily done.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 20, line 4, "interaction of said tip and said;" is improper.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 29, 30 and 33-35, as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Theodore et al. (U.S. Patent 5,338,932).

Regarding claims 29, 30 and 33-35, Theodore et al. disclose (see Figure 1) a scanning probe microscope assembly for examining an object (30), the scanning probe microscope assembly having a tunneling current mode and an atomic force mode (see column 2, lines 10-11), the microscope comprising: a probe having a base (13), a cantilever (12) connected to the base, and a tip (14) connected to the cantilever; tunneling current means (16, 29) for inducing and detecting a tunneling current between the tip and the object during the tunneling current mode; and atomic force means (26, 27, positioning means (not shown)) for inducing atomic force interaction between the tip and the object and for detecting deflection of the cantilever due to the atomic force interaction during the atomic force mode; and holding means (15, 17, 18) for immobilizing the tip (see col. 4, lines 30-35, stiffness of ten thousand Newton/meter) with respect to the base during the tunneling current mode (see also column 3, lines 55-60). Theodore et al. further disclose (see Figure 1) providing a clamping structure (15,

17, 18) connected to the base and controlling the clamping structure to immobilize the tip with respect to the base during the tunneling current mode. Theodore et al. also disclose (see Figure 1) the cantilever has an upper and lower surface and holding is accomplished by a member (11) over the upper surface of the cantilever; providing an insulating layer (air) between the cantilever and the member and applying a voltage to immobilize the tip as claimed.

Allowable Subject Matter

6. Claims 1-8, 10-19, 21-28, 31, 32, 40-42 and 55-57 are allowed over the prior art of record.
7. Claim 20 would be allowable once the 112 2nd paragraph rejection is overcome.
8. Claims 36-39 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed June 4, 2004 have been fully considered but they are not persuasive.

Applicant asserts that the prior art does not disclose the tip being immobilized. Examiner disagrees. Upon closer inspection of the Theodore et al. reference, it further disclose (see col. 4, lines 30-35 and claim 25) the stiffness of the cantilever is 10,000 newtons/meter. As understood, a cantilever with such a stiffness value provides a tip that is immobile as claimed.

Thus, as set forth above, this rejection is proper.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is (571) 272-2441. The examiner can normally be reached on M-F (6:30-4:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
Art Unit 2878

07/2004